

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant	:	Kain et al.	Group Art Unit 1634
Appl. No.	:	10/638,173	
Filed	:	August 6, 2003	
For	:	ALTERNATIVE SUBSTRATES AND FORMATS FOR BEAD- BASED ARRAY OF ARRAYS™	
Examiner	:	B.J. Forman	

**TERMINAL DISCLAIMER UNDER 37 C.F.R. § 1.321(c)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

*Empowerment of Attorney*

Pursuant to 37 C.F.R. §§ 1.34(b) and 1.321(b) the undersigned attorney of record is empowered to act on behalf of the Assignee, Illumina, Inc. ("Assignee").

*Right of Assignee and Ownership*

In accordance with 37 C.F.R. § 3.73(b), Assignee represents that it is the owner of the entire interest in the above-identified application, by virtue of assignment recorded at Reel No. 012272, Frame No. 0287 by the Assignment Branch of the Patent and Trademark Office. Assignee also represents that it is the owner of the entire interest in U.S. Patent No. 6,998,274, which is a division of U.S. Patent No. 6,429,027, by virtue of assignment, a copy of which is provided herewith. The Assignee represents that, to the best of Assignee's knowledge and belief, title is in the Assignee seeking to take action.

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*Disclaimer by Assignee*

Assignee hereby disclaims, except as provided below, the terminal part of any patent granted on the above-referenced application that would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,998,274, and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the instant application and U.S. Patent No. 6,998,274 are co-owned. This agreement extends to any patent granted on the above-referenced application and shall be binding on its successors or assigns.

Assignee does not disclaim any terminal part of any patent granted on the above-referenced application prior to the earlier of the expiration date of the full statutory term of U.S. Patent No. 6,998,274, and that of any patent issuing on the above-identified application in the event that either one later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to expiration of its statutory term, except for the separation of legal title stated above.

Applicant also notes that the filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991). The filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting and raises neither presumption nor estoppel on the merits of the rejection.

This Terminal Disclaimer is accompanied by the \$65 fee set forth in 37 C.F.R. § 1.20(d).

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 14, 2006

By: 

Jerry L. Heimer  
Registration No. 53,009  
Attorney of Record  
Customer No. 20,995  
(619) 235-8550

## ASSIGNMENT

(NOT ACCOMPANYING APPLICATION)

WHEREAS, the undersigned,

(1) Mark S. CHEE, (2) Steven R. AUGER

(3) John R. STUELPNAGEL, (4) \_\_\_\_\_

(hereinafter termed "Inventors"), residents of

(1) Del Mar, (2) San Diego

(3) Encinitas, (4) \_\_\_\_\_

respectively, Counties of

(1) San Diego, (2) San Diego,

(3) San Diego, (4) \_\_\_\_\_

respectively, States of

(1) California, (2) California,

(3) California, (4) \_\_\_\_\_

respectively, have invented certain new and useful improvements in

COMPOSITE ARRAYS UTILIZING MICROSPHERES

and have executed an application for a United States patent disclosing and identifying the invention on even date herewith; and having Serial No. 09/256,943 and filing date of 24 February 1999; and

WHEREAS, Illumina, Inc. a corporation of the State of California, having a place of business at 9390 Towne Centre Drive, Suite 200, San Diego, 92121, State of California, (hereinafter termed "Assignee"), is desirous of acquiring the entire right, title and interest in and to said application and the invention disclosed therein, and in and to all embodiments of the invention, heretofore conceived, made or discovered jointly or severally by said Inventors (all collectively hereinafter termed "said invention"), and in and to any and all patents, inventor's certificates and other forms of protection (hereinafter termed "patents") thereon granted in the United States and foreign countries.

NOW, THEREFORE, in consideration of good and valuable consideration acknowledged by said Inventors to have been received in full from said Assignee:

1. Said Inventors do hereby sell, assign, transfer and convey unto said Assignee, the entire right, title and interest (a) in and to said application and said invention; (b) in and to all rights to apply for foreign patents on said invention pursuant to the International Convention for the Protection of Industrial Property or otherwise; (c) in and to any and all applications filed and any and all patents granted on said invention in the United States or any foreign country,

including each and every application filed and each and every patent granted on any application which is a division, substitution, or continuation of any of said applications; and (d) in and to each and every reissue or extensions of any of said patents.

2. Said Inventors hereby jointly and severally covenant and agree to cooperate with said Assignee to enable said Assignee to enjoy to the fullest extent the right title and interest herein conveyed in the United States and foreign countries. Such cooperation by said Inventors shall include prompt production of pertinent facts and documents, giving of testimony, execution of petitions, oaths, specifications, declarations or other papers, and other assistance all to the extent deemed necessary or desirable by said Assignee (a) for perfecting in said Assignee the right, title and interest herein conveyed; (b) for prosecuting any of said applications; (c) for filing and prosecuting substitute, divisional, continuing or additional applications covering said invention; (d) for filing and prosecuting applications for reissuance of any said patents; (e) for interference or other priority proceedings involving said invention; and (f) for legal proceedings involving said invention and any applications therefor and any patents granted thereon, including without limitation opposition proceedings, cancellation proceedings, priority contests, public use proceedings, infringement actions and court actions; provided, however, that the expense incurred by said Inventors in providing such cooperation shall be paid for by said Assignee.

3. The terms and covenants of this assignment shall inure to the benefit of said Assignee, its successors, assigns and other legal representatives, and shall be binding upon said Inventors, their respective heirs, legal representatives and assigns.

4. Said Inventors hereby jointly and severally warrant and represent that they have not entered and will not enter into any assignment, contract, or understanding in conflict herewith.

IN WITNESS WHEREOF, the said Inventors have executed and delivered this instrument to said Assignee as follows:

Date: 5/13/1999

(1) Mark S. Chee  
Mark S. CHEE

County of \_\_\_\_\_ )  
State of \_\_\_\_\_ ) ss.  
\_\_\_\_\_ )

On this 13<sup>th</sup> day of May, in the year 1999, before me, Kristine Gail Farmer, Notary Public of the State of California, personally appeared (1) Mark S. CHEE personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity(ies), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Kristine Gail Farmer



(Seal)

Date: 5/13/1999

(2) Steven R. Auger  
Steven R. AUGER

County of \_\_\_\_\_ )  
State of \_\_\_\_\_ ) ss.  
\_\_\_\_\_ )

On this 13<sup>th</sup> day of May, in the year 1999, before me, Kristine Gail Farmer, Notary Public of the State of California, personally appeared (2) Steven R. AUGER personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity(ies), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Kristine Gail Farmer



(Seal)

Date: 5/13/99

(3) John R. Stuelpnagel  
John R. STUELPNAGEL

County of \_\_\_\_\_

.)  
) ss.

State of \_\_\_\_\_

.)

On this 13<sup>th</sup> day of May, in the year 1999, before me, Kristine Gail Farmer, Notary Public of the State of California, personally appeared (3) John R. STUELPNAGEL personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged that he/she executed the same in his/her authorized capacity(ies), and that by his/her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

Signature Kristine Gail Farmer



(Seal)

COPY  
DO NOT RECORD